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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,517	10/31/2000	Timothy A. McDonough	03797.00007	7863

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EXAMINER

ABDULSELAM, ABBAS I

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/699,517

**Applicant(s)**

MCDONOUGH ET AL.

**Examiner**

Abbas I Abduselam

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 07/11/03 have been fully considered but they are not persuasive.

Applicant argues that the cited reference Adan et al. (USPN 6373046), Katrinecz et al. (USPN 6199996) and Duphorne (USPN 6212265) alone or in combination do not teach an input device having an illuminating member. However, as stated in the art rejection below, Katrinecz teaches a mouse with a feature of illumination. See Fig. 2. Applicant argues the email notification device (20) cited from Duphorne's reference is not a computer input device. However, the email notification device is intended to satisfy the desired determination of "predetermined event". In addition, Duphorne discloses that the email notification device may be used in different ways including the device being coupled to one or more compatible peripheral device. Duphorne teaches the user notification device with respect to appropriate parameters that may be inserted, modified, deleted and entered through suitable communication means. See col. 9, lines 49-67. Therefore, it would have been obvious to utilize, Duphorne's email notification features in compatible with any input device.

2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the user being excluded for causing the intensity of light illumination,) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It would have been obvious to one skilled in the art at the time the invention was made to modify Adan's input device system to include Katrinecz's illuminating feature. One would have been motivated in view of the suggestion in Katrinecz that the illuminating feature is functionally equivalent to the desired illuminating member of the input device. The use of an illuminating feature in an input device helps control visual attributes and functionalities as taught by katrinecz. Moreover, It would have been obvious to one having skill in the art at the time the invention was made to modify Adan's computer system to adapt Duphorne's email notification feature. One would have been motivated in view of the suggestion in Duphorne that the email notification equivalently performs the desired determination of a predetermined event. The use of email notification device helps function a computer system with Internet connection.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Adan et al. (USPN 6373047) in view of Katrinecz (USPN 6199996) and Duphorne (USPN 6212265).

Regarding claims 1, 6, and 28, Adan teaches an input device system including a processing unit (21), a hard disk drive (27), a magnetic disk drive (28) and optical disk drive along with associated computer readable media storing computer readable instructions. Adan also teaches that when mouse (42) is moved over high-resolution zone (144), a control component determines that the mouse is over a zone having a predetermined pattern. See Fig 1 and Fig 6. However, Adan does not teach an illumination member of an input device that changes states. Katrinecz on the other hand teaches a data entry device including a mouse, which has a feature of illumination with various characteristics. See col. 1, lines 10-15 and 55-57.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Adan's input device system to include Katrinecz's illuminating feature. One would have been motivated in view of the suggestion in Katrinecz that the illuminating feature is functionally equivalent to the desired illuminating member of the input device. The use of an

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illuminating feature in an input device helps control visual attributes and functionalities as taught by Katrinecz.

Adan has been described above. However, Adan does not teach the use of input device in connection to step of determining in a computer whether a predetermined event has occurred. Duphorne discloses an email notification device (20) including an alert system indicating means, which activates upon receipt of the email notification signal (40) so that a user can retrieve the email messages from personal computer. See col. 7, lines 12-31, Fig1 and Fig 6.

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify Adan's computer system to adapt Duphorne's email notification feature. One would have been motivated in view of the suggestion in Duphorne that the email notification equivalently performs the desired determination of a predetermined event. The use of email notification device helps function a computer system with Internet connection.

Regarding claim 2, Adan teaches the use of an input device for the purpose of providing specialized messages to the computer. See Fig 11.

Regarding claims 3-5, 21-23 and 30-32, Katrinecz teaches the use of illumination with various colors and intensities. See col. 2, lines 14-18 and 19-31.

Regarding claims 7 and 27, Adan teaches a "mouse message hook" that executes and returns a value to the operating system (35). See col. 7, lines 15-20.

Regarding claims 8-15, 25-26 and 29, Adan's Fig 10B (192, 196).

Regarding claims 16-18, Adan teaches a control component (124) with respect to a predetermined time out period and the velocity of the mouse over the surface (116). See col. 9, lines 28-44.

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Regarding claims 19-20, Adan teaches the use of the input device with respect to game applications utilize the functionalities of the device. See Fig 3.

Regarding claim 24, Adan teaches the input device system for providing position information based on the movement of the input device. See col. 1, lines 24-28.

Regarding claims 33-34, see Adan's Fig 2A (42).

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Abbas Abdulsalam** whose telephone number is **(703) 305-8591**. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard Hjerpe**, can be reached at **(703) 305-4709**.

**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Hand delivered responses should be brought to Crystal Park II, Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 2600 customer Service office whose telephone number is (703) 306-0377.

Abbas Abdulsalam

Examiner

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September, 17, 2003



**RICHARD HJERPE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600**